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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 16

Application Number: 09/181,151  
Filing Date: 10-28-1998  
Appellant(s): Alistair. R Hamilton

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Gregory A. White  
For Appellant

**EXAMINER'S ANSWER**

This is in response to appellant's brief on appeal filed 1-8-2002.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

None

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**(3) Status of Claims**

The statement of the status of the claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

Appellant's brief includes a statement that claims Group 1: claims 1, 3, 4, 7, and 9, the claims in this group stand or fall together, with the exception of claim 1 and 3, which do not stand or fall together; Group 2: claims 2, 5, 6, 8, and 10, the claims in this group stand or fall together; Group 3: claims 11-13, the claims in this group do not stand or fall together; Group 4: claim 14, Appellant provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

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5,371,534	Dagdeviren et al.	12/1994
JP409023414A	Morino et al.	1/1997
H1714	Partridge, III	3/1998

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-4, 7 and 9, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dagdeviren et al. (US PAT: 5,371,534, hereinafter Dagdeviren) in view of Partridge, III (US PAT: H1714).

Regarding claims 1, Dagdeviren discloses a method of establishing audio-video conference comprising: holding an audio only conference , holding an audio conference accompanied by a live video conference (figs. 1, 4, col. 8 lines 27-68).

Regarding claim 3, Dagdeviren teaches an apparatus (fig. 1) comprising: a computer readable storage medium (215, fig. 2) , a software means, physically configured in the storage medium, receiving image data from a remote location and displaying it, holding an initial audio conference with a remote communication device, holding a sequel to the audio conference with

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the remote device, and holding a video conference with the remote device during the sequel (figs. 1, 4, col. 8 lines 27-68).

Dagdeviren differs from the claimed invention by not teaching displaying static visual images during the audio only conference.

However, Partridge discloses automatic still image transmission which teaches displaying static visual images during the audio only conference (figs. 1-2, col. 3 lines 42-67, col. 4 lines 1-8).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Dagdeviren's system to provide for displaying static visual images during the audio only conference as this would enable call screening based upon calling party's image as taught by Partridge (col. 1 lines 37-43).

Regarding claims 4, 7, 9, Dagdeviren further teaches the following: initial audio conference is held using a POTS line, and sequel is held using a high-bandwidth channel, live video conference utilizes a communication channel (112,117,119), and the audio only conference utilizes a sub-channel of the communication channel, live video conference utilizes a relatively high-bandwidth communication channel (figs. 1, 4, col. 8 lines 27-68).

3. Claims 11-14<sup>14</sup> are rejected under 35 U.S.C. 103(a) as being unpatentable over Dagdeviren in view of Morino et al. (JP409023414A, hereinafter Morino).

Regarding claim 11-13, Dagdeviren does not teach the following: during setting-up step, displaying static pictures of the conference participants on equipment latter used to hold the audio

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video conference, terminating display of the static pictures after setting-up complete, replacing each static picture by a live video image of the participant depicted in the static picture.

However, Morino discloses video conference system which teaches the following: during setting-up step, displaying static pictures of the conference participants on equipment latter used to hold the audio video conference, terminating display of the static pictures after setting-up complete, replacing each static picture by a live video image of the participant depicted in the static picture (fig. 1, see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Dagdeviren's system to provide for the following: during setting-up step, displaying static pictures of the conference participants on equipment latter used to hold the audio video conference as this would facilitate the conference participants to know other conferees that are participating in the conference, terminating display of the static pictures after setting-up complete, replacing each static picture by a live video image of the participant depicted in the static picture as this arrangement would facilitate the obtaining live and dynamic image of the conference participants as taught by Morino, thus enhancing the video conferenceing capability of Dagdeviren's apparatus.

Regarding claim 14, Dagdeviren does not teach the following: the static video images each depict a different person.

However, Partridge teaches the following: the static video images depict a different person (col. 2 lines 61-65, col. 4 lines 51-53).

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Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Dagdeviren's system to provide for the following: the static video images each depict a different person as this arrangement would facilitate corporate presentation of slide show as taught by Partridge, thus enhancing the capability of Dagdeviren's system.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 2, 5-6, 8, 10 are rejected under 35 U.S. C 102(b) as being anticipated by Dagdeviren.

Regarding claim 2, Dagdeviren teaches setting up an audio-video conference on a high bandwidth communication channel (112,117,119, figs. 1, 3, col. 7 lines 29-67, col. 8 lines 1-26), during setting up step, holding an audio conference using a POTS channel (111,116,118, fig. 1), and after setting up completes, holding audio-video conference on the high-bandwidth channel, and terminating the audio conference on the POTS channel (figs. 1, 4, col. 8 lines 27-68).

Regarding claims 5-6, 8, 10, Dagdeviren further teaches the following: parties who participate in the audio-video conference are the same parties who participate in the audio conference, audio conference is held using telephones (101,121, fig. 1), and prior to audio conference, a telephone company issued ring signals to at least some of the telephones (inherent),

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audio-video conference utilizes a communication channel (112,117,119, fig. 1), audio conference utilizes a sub-channel of the communication channel (fig. 3, col. 7 lines 29-68, col. 8 lines 1-26), audio-video conference utilizes a relatively high bandwidth communication channel, and audio conference utilizes a relatively low-bandwidth POTS channel (figs. 1, 4, col. 8 lines 27-68).

***(11) Response to Argument***

Appellant's remarks have been fully considered but they are not persuasive.

1. Rejection of claim 1 as obvious, based on Dagdeviren and Partridge: Regarding rejection of claim 1, Appellant argues on page 3 of last paragraph of his Appeal brief that "No teaching for combining the references has been given which ...prohibits "broad conclusory statements."" With respect to this argument, Appellant attention is directed to the fact Partridge does provide solid foundation and motivation to combine it with Dagdeviren in that Partridge teaches using static image of a caller as an extension of caller ID function to screen calls (col. 1 lines 36-43). This teaching of Partridge provides objective evidence which is clear and particular to modify Dagdeviren's system which teaches setting up audio only call between the users (col. 2 lines 62-68). By applying teachings of Partridge in Dagdeviren, it enables the Dagdeviren's system to have call screening capability with the result that it allows the called party to answer the call from a conferee to set up the conference call and provides an improvement to Dagdeviren system.
2. Rejection of claim 2 as being anticipated by Dagdeviren: Regarding rejection of claim 2, Appellant argues on page 5 of last two paragraphs of his Appeal brief that "But Dagdeviren's voice channel of an ISDN channel is not a "POTS channel". The POTS ... are analog lines".



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Contrary to Appellant's interpretation of Dagdeviren reference, he clearly teaches the following: during the set-up step, holding an audio conference using POTS channel (reads on voice grade channel, fig. 4, col. 8 lines 27-68). Appellant argues on page 6 of first paragraph of his Appeal brief that "Further, claim (2c) recites terminating the POTS call ... However, that voice call ... is not a POTS call". Notwithstanding Appellant's assertion to the contrary, Dagdeviren clearly teaches terminating audio conference on POTS channel (reads on voice grade channel, note: col. 3 lines 3-5 and also see items 411-412 of fig. 8) which meets the Appellant claim limitation of claim 2.

3. Rejection of claims 11-13, based on Dagdeviren and Morino: Regarding rejection of claims 11-13, Appellant argues on page 6 of last three paragraphs of his Appeal brief that "Claim 11 depends on claim 2, and states that static images are displayed during "the setting up step" of claim 2. Morino may display "static images", but not during such a "setting up step."". Examiner disagrees Appellant's interpretation of Morino reference in that Morino clearly teaches the following: during the setting-up step, displaying static pictures of the conference participants on equipment latter used to hold the audio-video conference (fig. 1, see abstract). Further, it is to be stressed that Morino displays static pictures of the conference participants during setting-up step as is clear from abstract. Appellant further argues that "In fact, in Morino, the static images are used to select the participants of forthcoming video conference". Be this as it may, Morino still displays static images during conference setting-up step as required by claim 11 (see abstract). Appellant further argues on page 7 of third paragraph of his Appeal brief that "In addition, the

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rationale for combining ... The rationale is that the combination “enhances” Dagdeviren. This is not (1) objective evidence, (2) found in the prior art, which is (3) “clear and particular.” It is a purely conclusory statement, prohibited by Dembiczak”. Appellant argument regarding this is not persuasive in that Morino clearly provides (1) objective evidence in much as Morino teaches displaying static pictures of the conference participants on equipment later used to hold the audio video conference, terminating the static pictures after setting up step completes , and replacing static picture by a live picture (fig. 1, see abstract) as is clear from the abstract (2) found in the prior art which is Moriono reference , which is (3) “clear and particular”, in that Moriono teaches Appellant’s claim limitations of claims 11-13. As can be seen from this, it is not a purely conclusory statement to apply this teaching in Dagdeviren’s system to provide for enhancement of his system to provide better service to the user of the system as taught by Morino.

Regarding rejection of claims 1, 3, 4, 7, and 9 as obvious based on Dagdeviren and Partridge: Appellant makes similar arguments on pages 7-13 which are previously addressed in earlier treatment of rejection of claims 1-2, and 11-13 as set forth above and are not persuasive.

Appellant further alleges problems created by the combination of the references used in the rejection and these problems are addressed below:

First problem: Appellant argues regarding this on page 14 of third and fourth paragraphs of his Appeal brief that “Further, the rationale says nothing more than that the references could be combined. But MPEP section just cited prohibits this type of rationale”. Regarding this, Appellant belabors this argument in that Appellant fails to recognize motivation to combine the

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references set forth in the office action dated 6-12-2001. For example office action on page 3 states that Dagdeviren differs from the claimed invention by not teaching displaying static visual images during the audio only conference.

However, Partridge discloses automatic still image transmission which teaches displaying static visual images during the audio only conference (figs. 1-2, col. 3 lines 42-67, col. 4 lines 1-8).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Dagdeviren's system to provide for displaying static visual images during the audio only conference as this would enable call screening based upon calling party's image as taught by Partridge (col. 1 lines 37-43).

It is clear from this a sound rationale for combining the reference above has been established.

Appellant refers to the second problem in combining references: "A second problem ... no reason to add Dagdeviren". With respect to this, Appellant is simply misinterpreting the rationale for combining Dagdeviren with Partridge in that Dagdeviren does not teach call screening whereas Partridge teaches call screening using static images displayed on called terminal in connection with call (col. 1 lines 36-43). By applying teachings of Partridge in Dagdeviren, Dagdeviren system would have call screening capability to allow the called party to handle the call depending upon who the caller is. This provides the rationale for combining the references.

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Appellant refers to the third problem in combining references: "But, contrary to Dagdeviren, the combination of references, by virtue of Partridge, states that a video-only call (the picture of the caller) should be set up first. That is a modification of Dagdeviren". Here again, Appellant is simply interpreting Partridge reference to suite his argument. Partridge does not say video only call as alleged by the Appellant. Rather, Partridge refers to call screening based on caller ID, based on calling party's number and providing a useful extension of this concept that permitted call screening based on calling party's image (col. 1 lines 36-43). So Partridge system provides call screening capability which is applied to Dagdeviren to obtain call screening capability without resulting in any fundamental modification of Dagdeviren's system as alleged by the Appellant.

Appellant refers to the fourth problem in combining references: "Partreidge states that visual image of the caller is received and displayed on the called party's equipment , even before called party "answers" the call, as by lifting the handset. (Column 5, last paragraph.). That is, the image ... Dagdeviren is clearly contrary. He states that his processing is only after a communication channel is voluntarily established between parties". Again Appellant is selectively quoting from the Partreidge reference in that he not only teaches what Appellant refers to above, but he also teaches displaying image of the caller on called party display terminal some time after off-hook has been detected which can be programmed in the processor (60, fig. 2, col. 3 lines 66-67, col. 4 lines 1-8). Therefore, combination of Dagdeviren and Partridge is not improper as alleged by the Appellant.

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Appellant refers to the fifth problem in combining references: “ In Dagdeviren, a caller initiates a digital audio call, using video phone. Then ... digital audio call into a audio/video call. Partridge, as described above, transmits a static picture even before the called party answers ... Those are unrelated processes. The references are non-analogous”. Again Appellant is misinterpreting the references. For example Dagdeviren states setting up voice grade call (see item 401 of fig. 4) not digital audio call as alleged by Appellant. Similarly Partridge sets up a audio call and states that the caller static picture could be displayed some period after off-hook has ben detected (col. 4 lines 1-8), and not only before the called party answers as Appellant selectively quotes from the reference. Therefore, the references are not non-analogous as alleged by the Appellant and therefore the references are combinable.

Appellant refers to the sixth problem in combining references: “Assume that Partridge’s recipient ... In such a case; no audio call is established, so no conversion to video call, as in Dagdeviren, is even possible. These aspects of the references cannot be combined, there is no call to convert”. Appellant is selectively creating the scenarios to advance his argument against combining the references while ignoring the scenario where audio call is accepted by the user and then converted into video call as taught by the combination of the references. Appellant further argues on page 18 , first paragraph of his Appeal Brief that “Even if Partridge’s ... Dagdeviren switches from a digital audio call to a digital audio-video call”. Again Appellant is misinterpreting Dagdeviren reference in that Dagdeviren states setting up a POTS call (reads on voice grade call, see item 401 of fig. 4) not digital audio call as alleged by the Appellant. Partridge also teaches

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setting up audio POTS calls (col. 1 lines 27-30). Therefore, the references can be combined as shown above.

Regarding this Appellant on page 18 , last two paragraphs and continued on first two paragraphs of page 19, of his Appeal Brief is selectively making arguments by misinterpreting the references which are not persuasive.

Appellant refers to the eighth problem in combining the references: "If Partridge's device is substituted into Dagdeviren, to allow ... to accept video calls initially". Again Appellant misinterpreting Partridge's reference in that he teaches the setup of the audio call, not a video call as alleged by the Appellant and sends still image of the caller to identify the caller to the called party terminal as an extension of caller ID concept (col. 1 lines 36-42). So in view of this, the references can be combined.

Appellant refers to the ninth problem in combining the references: "Thus, nothing useful is attained by combining references. If you give the recipient a video phone, as Partridge requires, then the need for Dagdeviren evaporates. Dagdeviren is based on premise that the recipient may not have a video phone". Regarding this, although Partridge mentions video telephone, he is not setting up a video call; he is basically setting up audio call and sends still image to establish caller identity to the called party (col. 1 lines 6-9). This is no way tantamount to setting up a video telephone call as alleged by Appellant, whereas Dagdeviren sets up a audio call first, then converts into audio and video phone call (see dig. 4). Therefore, Dagdeviren as modified by

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Partridge provides call screening capability in Dagdeviren's system which does not mean achieving nothing as alleged by the Appellant.

Regarding rejection of claim 1, Appellant further argues on page 22 , first paragraph of his Appeal Brief that " Partridge does not show multiple static images, in connection with a single conference. He only shows the picture of the single caller". Regarding this, Partridge also teaches displaying more than one image such as: a corporate presentation slide show may be selected by the customer (col. 2 lines 58-65, col. 4 lines 51-53) for presentation which meets the Appellant claim limitation of displaying static visual images during audio only conference as required by claim 1. Therefore, a prima facie case of obvious rejection of claim 1 is established based on Dagdeviren and Partridge.

Regarding rejection of claim 1, Appellant further argues on page 22 , last three paragraphs of his Appeal Brief that "Restated, where is the teaching to overcome Partridge's maintenance of a one-way image stream, and replace it with Dagdeviren's two way video?". Appellant arguments are not persuasive in that Partridge teaches displaying static visual images during audio only conference (col. 4 lines 1-8) and Dagdeviren teaches converting the audio only conference to audio video conference (fig. 4). The combination of them teaches the claim limitations of claim 1.

Regarding rejection of claim 2 based on Dagdeviren, Appellant further argues on page 24 , last three paragraphs of his Appeal Brief that "Applicant previously requested ... Those do not show the recitation in question which is this: b) during the setting-up step, holding an audio conference using a POTS channel". With respect to this, Examiner has already pointed out

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setting up a voice grade call (item 401 of fig. 4 of Dagdeviren reads on limitations of claim 2 such as: during the setting-up step, holding an audio conference using a POTS channel). Appellant further belabors this argument without recognizing Dagdeviren teaching as pointed out above.

Rejection of claims 11-13, based Dagdeviren and Morino: Regarding rejection of claim 11, Appellant argues on page 27, last three paragraphs of his Appeal Brief that "Morino is directly contrary to that operation. Morino ... no conference call is being held, contrary to claim 2". Notwithstanding Appellant's arguments on this, Morino reference is used to apply his teaching which teaches step (d): during the setting-up step ... to hold audio video conference (fig. 1, see abstract). Therefore, Dagdeviren modified by Morino teaches claim limitation of claim 11.

Regarding rejection of claim 12, Appellant further argues on page 28, first paragraph of his Appeal Brief that "Claim 12 recites terminating static pictures ... has not identified it". With respect to this, it is to be pointed out that Morino teaches displaying static pictures during the setting up of the conference, once this is accomplished it implicitly mean terminating static pictures (fig. 1, see abstract).

Regarding rejection of claim 13, Appellant further argues on page 28 of his Appeal Brief that "The PTO has not identified this recitation in Morino". With respect to this, Appellant's attention is directed to the following implicit teaching in Morino: static pictures are displayed during conference set up, once this is accomplished, real images of the conferees follow for display (this is implicit in as much as it is a video conference environment and conferees will have real images displayed once a conference starts, note: fig. 1, see abstract).



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Regarding rejection of claim 14 based on Dagdeviren and Partridge, Appellant further argues on page 28, last paragraph of his Appeal Brief that "However, no teaching in the prior art has been identified in favor of this "enhancement"". With respect to this, Appellant's attention is directed to the following teaching in Partridge: he teaches that more than one image such as a corporate presentation slide show may be selected by the caller to present to the called party during audio call (col. 2 lines 61-65, col. 4 lines 51-53). This teaching used in Dagdeviren's system provides a definite enhancement to it so that Dagdeviren's system can be used to present the slide show during audio call set-up as taught by Partridge. Consequently, this provides the rationale for combining the references and examiner identifies this as one of the enhancements.

### Conclusion

For the above reasons, the examiner respectfully submits that a *prma facie* case of anticipation and obviousness of the claimed invention has been set forth in the Final office action and appellant(s) has/have failed to overcome the *prma facie* case of rejections. Accordingly, it is believed that the Final rejection under 35 U.S.C 102 and 103 is proper and Board of Patent Appeals and Interferences is therefore respectfully urged to affirm Examiner's rejection(s)

Respectfully submitted,

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